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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,758	06/30/1999	DIMITRI KANEVSKY	Y09-99-183	8306

7590 01/28/2002

RABIN & CHAMPAGNE
1725 K STREET NW
SUITE 1111
WASHINGTON, DC 20006

EXAMINER

VU, KIEU D

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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TM02/1107

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DATE MAILED: 11/07/01

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/343,758

Applicant(s)

KANEVSKY ET AL.

Examiner

Kieu D Vu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 6-12 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 23 is objected to because it contains an inappropriate period after the word "received" in line 6. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since these claims 26 claim "A computer program product" per se and does not positively recite that the program is stored on a medium that can be read by a machine. As such, the claimed invention is not directed to a machine readable medium or a manufacturer article.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 17 recites the limitation "the modified digital image " in line 13. There is insufficient antecedent basis for this limitation in the claim.
7. Regarding claim 18, it is not clear which "image" (line 8) to be displayed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 13-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al ("Donohue", USP 5987480).

Regarding claims 1 and 19, Donohue teaches a method of transferring data across a computer network (internet; col 7, lines 25-27), said computer network including a plurality of computers 2 (Fig. 1), a database stored on one of said plurality of computers (inherent), said method comprising the steps of:

requesting transfer of data stored (data source 12) on a remote computer system (server);

identifying at least one object (a document) included in said requested data as being associated with a generic object (a document template) and

substituting the generic object for each of said at least one object (abstract).

Donohue does not teach the setting data transfer constraints. Examiner takes Official Notice that setting data transfer constraints is well known in transferring data over network. It would have been obvious to one of ordinary skill in the art, having the teaching of Donohue before him at the time the invention was made, to modify the

interface method taught by to include the setting data transfer constraints with the motivation being to enable the system to set conditions while transferring data.

Regarding claim 2, Donohue teaches said stored data includes image and sound data (col 1, lines 62-63).

Regarding claim 3, Donohue teaches the displaying said web browser image (col 21, lines 46-47).

Regarding claim 4, Donohue teaches that the remote computer system identifies generic objects (selects one of document templates – abstract).

Regarding claims 5, 13, and 21, Donohue teaches that while the web browser image is being displayed, the remote computer system is transferring generic object codes associated with related images (delivering the populated document to the client computer – abstract).

Regarding claim 14, Donohue teaches an interface device for connecting to and retrieving data from a remote computer system (server), said interface device comprising:

means for requesting data from a remote computer system (inherent);

means for storing a plurality of generic objects, each stored generic object corresponding to an original object in data requested from said remote computer system (abstract; col 8, lines 10-13)

means for substituting each stored said generic objects for said corresponding object (abstract); and

means for outputting said requested data (displays on client computers), said output data selectively including said generic objects or corresponding original objects (displays on client computers).

Donohue does not teach the setting data transfer constraints. Examiner takes Official Notice that setting data transfer constraints is well known in transferring data over network. It would have been obvious to one of ordinary skill in the art, having the teaching of Donohue before him at the time the invention was made, to modify the interface method taught by to include the setting data transfer constraints with the motivation being to enable the system to set conditions while transferring data.

Regarding claim 15, Donohue teaches that the outputting means is a video display (col 1, lines 62-65).

Regarding claim 16, Donohue teaches that the interface device is a speaker (col 1, line 63).

Regarding claims 17-18, Donohue teaches a method of compressing digital images, comprising the steps of identifying objects (desired document – abstract), replacing identified objects with generic objects (document templates), position data and characteristics; and sending the modified digital image to a client system for display (delivering the populated document to the client computer – abstract). Donohue does not teach that the identifying objects includes the identifying names, position, and characteristics. It would have been obvious to one of ordinary skill in the art, having the teaching of Donohue before him at the time the invention was made, to modify the interface method taught by to include the identifying names, position, and

characteristics of objects with the motivation being to enable the system to better specify objects.

Regarding claim 20, Donohue teach a database with a plurality of generic objects (col 8, lines 10-11).

Regarding claim 23, Donohue does not teach the transferring requested object while a corresponding generic object is being displayed and when said requested object is received, replacing and displaying each corresponding generic object with each said requested object. However, Examiner takes Official Notice that the use of place holder is well known in the art. It would have been obvious to one of ordinary skill in the art, having the teaching of Donohue before him at the time the invention was made, to modify the interface method taught by to include place holder with the motivation being to enable the system to display the requested object when it is received.

Allowable Subject Matter

10. Claims 6-12 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 6 and 22, none of the prior art teaches or fairly suggests that when related images are displayed, said generic objects associated with said transferred generic object codes are substituted in said displayed related images in a specific combination as cited in claims 6 and 22.

12. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach about transferring objects which relate to the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232). The examiner can normally be reached on Mon - Fri from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone number for the organization where this application or proceeding is assigned are as follows:

(703)-746-7238 (After Final Communication)

or

(703)-746-7239 (Official Communications)

(703)-746-7240 (For Status Inquiries, draft communication)


and / or:

(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

Nov 2, 01


JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100